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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,595	02/06/2002	Van Miller	6164-47	5448

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EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/066,595	Applicant(s) MILLER ET AL.	
	Examiner David L. Sorkin	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 13 and 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 December 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (US 4,068,830). Note regarding the interpretation of the instant claims:

a. The instant claims make reference to materials intended to be acted upon by the claimed mixer during an intended operation, such as "color syrup additive" and "tempered, lipid-based formulation". However, "expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim[s]" *Ex parte Thilbault*, 164 USPQ 666,667 (Bd. App. 1969). Likewise, "[i]nclusion of material or article

worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

b. The instant claims recite several intended uses or operations of the mixer or parts thereof, such as operating the pump cyclically, feeding material in a continuous stream; and feeding material in discrete spaced apart quantities; however, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). Also, "recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham* 2 USPQ 1647 (Bd. Pat. App. & Inter. 1987).

Regarding claims 12 and 14, Gary ('830) discloses an apparatus comprising a storage tank (see col. 4, line 20); a mixing body (10,12,15) for evenly mixing to form a mixture, said mixing body having an outlet tube (10b) for said mixture; a feed tube (10a) couple to said storage tank for feeding formulation into said mixing body in a continuous stream; a reservoir (see col. 4, line 26) for additive; an injection port (11a) located at a position within the interior of said feed tube so as to be surrounded by said formulation as it flows into said mixing body. The mixing body is a jacketed ribbon blender (see Fig. 1), which is a corresponding structure disclosed in the instant specification for ensuring mixture is evenly colored as it exits said mixing body at said outlet tube. It is not explicitly stated that a pump is connected to the reservoir. However, it is considered that it would have been obvious to one of ordinary skill in the art to have provided a

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pump for the reservoir because of the express suggestion in col. 2 lines 3-4 that a pump is an alternative source of pressure for causing fluid flow. The reference does not disclose some of the acts recited in claim 12, such as operating the pump cyclically and locating discrete quantities of color syrup additive in a continuous stream of lipid based formulation; however, as explained above, apparatus claims do not cover acts, but instead cover structure. Any pump is intrinsically capable of being operated cyclically. The claims are clearly directed to the machine statutory category of invention, and are neither method claims nor improper *Ex parte Lyell* 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) type hybrid machine/method claims. A reference need not disclose or render obvious acts discussed in a machine claim to anticipate or render obvious the claim. Regarding claim 15, the quantitative values for flow rate in Table III would have suggested a proportional pump to one of ordinary skill in the art. Regarding claim 16, said injection port is centrally located within said feeding tube (see Fig. 1).

Allowable Subject Matter

4. Claims 13 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. The instant application discloses not structural details concerning the pump, but does describe a method of operating the pump cyclically. Any pump whether manually powered, electrically powered, pneumatically powered, hydraulically powered, etc. can be operated cyclically if one so desires. If applicant has invented a machine involving a

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particular pump structure, such a structure certainly was not described in the instant application as filed.

6. Applicant states "It would be evident to one skilled in the art within the context of an apparatus claim that a cyclically operating pump is a pump that operates cyclically when you switch it on". However, applicant's reference to pump being "switched on", versus for example being manually operated when desired, is not support by the disclosure. Furthermore, what may or may not automatically occur when the pump is "switched on" is not disclosed.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David L. Sorkin
Primary Examiner
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